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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

3 Applicant: Gorkem I. Ates
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6 Invention: INTERNET SYSTEM
7 Examiner: Hai V. Nguyen Agent's Doc. No.: ATEG21A
8 As article No.: EL586862255US EXPRESS MAIL I hereby certify,
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17 REPLY BRIEF UNDER 1.193 Technology Center 2100

18 Sir:

19 Applicant responds to the Examiner's Answer dated May 2,
20 2003, and files the instant Reply Brief in triplicate.

1 In the Claims:

2 1. (original) An Internet system, comprising:

3 a) a main server for storing information to be
4 requested over the Internet by a client so as to
5 form a request for information and having an IP
6 address; and

7 b) at least one participant server having an IP
8 address and electrically communicating with said
9 main server; said at least one participant server
10 not receiving the request for information from the
11 client, but rather said main server receiving the
12 request for information over the Internet from the
13 client and requesting over the Internet that said
14 at least one participant server send the requested
15 information over the Internet back to the client,
16 and if said at least one participant server does
17 not have the requested information, the requested
18 information is downloaded from said main server to
19 said at least one participant server, and when said
20 at least one participant server sends the requested
21 information over the Internet back to the client,
22 said at least one participant server assigns to the
23 requested information said IP address of said main
24 server and not said IP address of said at least one
25 participant server.

26 2. (original) The system as defined in claim 1, wherein said
27 main server is a TCP/IP server and assign jobs to said
28 at least one participant server dynamically without
29 relocating the client using neither HTTP nor HTML

1 commands so as to take relocating process away from top
2 networking OSI layers to 3rd level of Internet working
3 OSI that is IP so as to enable starting downloading of
4 the requested information from one of said at least one
5 participant servers and finishing the downloading from
6 another of said at least one participant server without
7 ever noticing server alteration by virtue of said at
8 least one participant server assigning to the requested
9 information said IP address of said main server and not
10 said IP address of said at least one participant server.

11 3. (original) The system as defined in claim 2, wherein said
12 top networking OSI is at least one of TCP, HTTP, and
13 application level.

14 4. (currently amended) A method for using an Internet
15 system, comprising the steps of:
16 a) making a request for information, over the
17 Internet, by a client, to a main server of the
18 Internet system and not to said at least one
19 participant server;
20 b) examining an IP address of the client, by said main
21 server;
22 c) seeking at least one participant server of the
23 Internet system, by said main server, so as to form
24 an at least one nearest participant server;
25 d) requesting over the Internet, by said main server
26 acting like an orchestra leader, that said at least
27 one nearest participant server send the requested
28 information to the client, packet-by-packet, over
29 the Internet;

1 e) determining if said at least one nearest
2 participant server has the requested information;
3 f) labeling, by said at least one nearest participant
4 server, each packet with an IP address of said main
5 server, which enables the client which has a port
6 open only for main server addresses to accept said
7 packets, if answer to step e) is yes;
8 g) sending the requested information with said IP
9 address of said main server, by said at least one
10 nearest participant server, to the client, over the
11 Internet;
12 h) downloading the requested information from said
13 main server to said at least one nearest
14 participant server, which will distribute the load
15 of said main server to said at least one
16 participant server when lacking multicasting so as
17 to save costs, by virtue of said at least one
18 participant server being relatively easy and
19 inexpensive to add as compared to clustering more
20 servers to said main server, if answer to STEP 5 e)
21 is no; and
22 i) returning to step f).

23 5. (original) The method as defined in claim 4, wherein said
24 step of making a request for information, over the
25 Internet, by the client, from the main server includes
26 making the request for at least one of a streaming video
27 and an audio, over the Internet, by the client, from the
28 main server.

1 6. (original) The method as defined in claim 4, wherein said
2 step of seeking the nearest at least one participant
3 server, by said main server, so as to form an at least
4 one nearest participant server includes seeking the
5 nearest at least one nearest participant server, by said
6 main server, so as to form said at least one nearest
7 participant server that has the most bandwidth and CPU
8 and other serving requirements needed to furnish the
9 requested information to the client.

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REMARKS

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Claim 4 has been currently amended.

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Applicant respectfully requests further examination and reconsideration of claims 1-6 still pending in the application.

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The last Office Action dated May 2, 2003 has been carefully considered and indicates that:

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a) Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention; and

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b) Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bendel et al. in view of Leighton et al.

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In response to the Examiner's rejection of claim 4 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, applicant has amended claim 4, line 29, to change "5" to --e)--.

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In view of the amendment made supra to claim 4, line 29, to change "5" to --e)--, applicant respectfully submits that the Examiner's grounds for the rejection of claim 4 under 35 U.S.C. 112, second paragraph, as being indefinite for failing

1 to particularly point out and distinctly claim the subject
2 matter which applicant regards as the invention are no longer
3 tenable and applicant therefore respectfully requests that the
4 Examiner withdraw this rejection.

5 In response to the Examiner's rejection of claims 1-6
6 under 35 U.S.C. 103(a) as being unpatentable over Bendel et
7 al. in view of Leighton et al., applicant respectfully submits
8 that pursuant to 37 CFR 1.111(c), claims 1 and 4 define the
9 following advantageous distinctive features, that distinguish
10 over, and avoid, the prior art:

11 a) "...said main
12 server... requesting
13 over the Internet
14 that said at least
15 one participant
16 server send the
17 r e q u e s t e d
18 information over the
19 Internet back to the
20 client..."[claim
21 1][Emphasis added];

22 b) "...if said at least
23 one participant
24 server does not have
25 the requested
26 information, the
27 r e q u e s t e d
28 information is
29 downloaded from said
30 main server to said
31 at least one
32 p a r t i c i p a n t
33 server..."[claim 1]
34 [Emphasis added];

35 c) "requesting over the
36 Internet, by said
37 main server acting
38 like an orchestra
39 leader, that said at
40 least one nearest

1 participant server
2 send the requested
3 information over the
4 Internet back to the
5 client..."[claim
6 4][Emphasis added];
7 and

8 d) "downloading the
9 r e q u e s t e d
10 information from
11 said main server to
12 said at least one
13 nearest participant
14 server, which will
15 distribute the load
16 of said main server
17 to said at least one
18 participant server
19 when lacking
20 multicasting so as
21 to save costs, by
22 virtue of said at
23 least one
24 participant server
25 being relatively
26 easy and inexpensive
27 to add as compared
28 to clustering more
29 servers to said main
30 server"[claim 4]
31 [Emphasis added].

32 It was decided in In re Miller, 169 USPQ 597 (CCPA 1971)
33 that each and every limitation, inter alia those discussed
34 supra, must be met in determining patentability:

35 "All words in a
36 claim must be
37 considered in
38 judging the
39 patentability of
40 that claim against
41 the prior art."[at
42 600][Emphasis added]

1 In this same regard, the Examiner's attention is
2 respectfully directed to the decisions in In re Fuetterer, 138
3 USPQ 217 (CCPA 1963); and In re Ludke and Sloan, 169 USPQ 563
4 (CCPA 1971).

5 When the Internet system of the present invention is
6 designed in accordance with the advantageous distinctive
7 features of claims 1 and 4 discussed supra, inter alia:

8 1. The at least one participant server can be located
9 anywhere in the world regardless of where in the world
10 the main server is located ipso facto "...said main
11 server... requesting over the Internet that said at least
12 one participant server send the requested information
13 over the Internet back to the client..."[claim
14 1][Emphasis added] and "requesting over the Internet, by
15 said main server acting like an orchestra leader, that
16 said at least one nearest participant server send the
17 requested information over the Internet back to the
18 client..."[claim 4][Emphasis added], as opposed to the
19 main server communicating with the at least one
20 participant server over a discrete and/or distinct and/or
21 dedicated connection.

22 2. Costly multicasting [the at least one participant server
23 is relatively easy and inexpensive to add as compared to
24 clustering more servers to the main server] is not
25 required if the at least one participant server does not
26 contain the requested information ipso facto "...if said
27 at least one participant server does not have the
28 requested information, the requested information is
29 downloaded from said main server to said at least one
30 participant server..."[claim 1][Emphasis added] and
31 "downloading the requested information from said main

1 server to said at least one nearest participant server,
2 which will distribute the load of said main server to
3 said at least one participant server when lacking
4 multicasting so as to save costs, by virtue of said at
5 least one participant server being relatively easy and
6 inexpensive to add as compared to clustering more servers
7 to said main server"[claim 4] [Emphasis added].

8 Even though the advantageous features of the present
9 invention discussed supra may not have been disclosed and
10 discussed specifically in the specification of the patent
11 application as it was originally filed, they still must be
12 relied upon as evidence of patentability, as was decided in
13 In re Chu, 66 F.3d 292, 36 USPQ.2d 1089 (Fed. Cir. 1995),
14 where the Court held:

15 "Board of Patent
16 Appeals and
17 Interferences erred,
18 in upholding
19 obviousness
20 rejection of
21 applicant's claims,
22 by concluding that
23 claims' disclosure
24 was matter of
25 "design choice," and
26 that the applicant's
27 evidence and
28 arguments to
29 contrary are not
30 present in
31 specification and
32 are therefore
33 unpersuasive, since
34 board is required to
35 consider totality of
36 record and is not
37 free to disregard
38 evidence and
39 arguments presented
40 by applicants, and

1 since there is no
2 support for
3 proposition that
4 evidence and/or
5 arguments traversing
6 35 USC 103 rejection
7 must be contained
8 w i t h i n
9 specification, given
10 that obviousness is
11 determined by
12 totality of record
13 including, in some
14 instances most
15 significantly,
16 evidence and
17 arguments proffered
18 during give-and-take
19 of ex parte patent
20 prosecution." [at
21 1090] [Emphasis
22 added]

23 "Because the Board
24 was required to
25 consider the
26 totality of the
27 record, the Board
28 was not free to
29 disregard the
30 evidence and
31 arguments presented
32 by Chu in response
33 to the obviousness
34 r e j e c t i o n .
35 Additionally, the
36 Board erred in
37 apparently requiring
38 Chu's evidence and
39 arguments responsive
40 to the obviousness
41 rejection to be
42 within his
43 specification in
44 order to be
45 considered. To
46 require Chu to

1 include evidence and
2 arguments in the
3 specification
4 regarding whether
5 placement of the SCR
6 catalyst in the bag
7 retainer was a
8 matter of "design
9 choice" would be to
10 require patent
11 applicants to divine
12 the rejections the
13 PTO will proffer
14 when patent
15 applications are
16 filed. " [at
17 1094] [Emphasis
18 added]

19 "We have found no
20 cases supporting the
21 position that a
22 patent applicant's
23 evidence and/or
24 arguments traversing
25 a § 103 rejection
26 must be contained
27 within the
28 specification.
29 There is no logical
30 support for such a
31 proposition as well,
32 given that
33 obviousness is
34 determined by the
35 totality of the
36 record including, in
37 some instances, most
38 significantly, the
39 evidence and
40 arguments proffered
41 during the give-and-
42 take of ex parte
43 p a t e n t
44 prosecution." [at
45 1095] [Emphasis
46 added]

1 And, even though the present invention may be considered
2 simple and accomplishes only a small but genuine improvement
3 by some is not sufficient reason to deny it patent protection,
4 as was decided in Schnell et al. v. The Allbright-Nell Company
5 et al., 146 USPQ 322 (Court of Appeals, Seventh Circuit 1965),
6 where the Court held:

7 "Device seems simple
8 and obvious in light
9 of patentee's
10 teaching, but it
11 evidently was not
12 obvious at time of
13 invention; those
14 working in the field
15 did not accomplish
16 patentee's results;
17 that fact supports
18 conclusion that
19 patentee achieved
20 p a t e n t a b l e
21 invention." [at
22 322] [Emphasis added]

23 "This now seems
24 simple and obvious
25 in the light of the
26 Schnell teaching,
27 but is was evidently
28 not at all obvious
29 at the time of the
30 invention. Those
31 working in the field
32 did not accomplish
33 Schnell's results.
34 That fact supports
35 the conclusion that
36 Schnell achieved
37 p a t e n t a b l e
38 inventions. Pyle
39 Nat. Co. v. Lewin, 7
40 Cir., 1937, 92 F.2d
41 628, 630, 35 USPQ
42 40, 42." [at 324]
43 [Emphasis added]

1 The Board of Appeals expressed the same concept when it
2 held in Ex parte Grasenick and Gessner, 158 USPQ 624 (Patent
3 Office Board of Appeals 1967), that:

4 "Improvement over
5 prior art, even
6 though it be simple
7 or involves only a
8 reversing of certain
9 parts, is patentable
10 unless prior art
11 shows that
12 improvement is
13 obvious." [at 624]
14 [Emphasis added]

15 "This rejection is
16 in error. An
17 improvement over the
18 prior art, even
19 though it be simple
20 or involves only a
21 reversing of certain
22 parts, is patentable
23 unless the prior art
24 shows the
25 improvement to be
26 obvious. The
27 examiner has neither
28 cited evidence
29 establishing the
30 obviousness of
31 a p p e l l a n t ' s
32 modification of the
33 prior art nor
34 demonstrated that
35 the improved results
36 c l a i m e d by
37 appellants are not
38 available from their
39 construction." [at
40 624] [Emphasis
41 added]

42 Attention is also respectfully directed in this regard
43 to the decisions in Mercantile National Bank of Chicago et al

1 v. Quest, Inc. et al. DC., N.D. Indiana, 166 USPQ 517; In re
2 Shelby, 136 USPQ 220; and In re Irani and Moedritzer, 166 USPQ
3 24, which all indicate that simplicity does not operate as a
4 bar to patentability if the invention was unobvious at the
5 time it was made.

6 Turning now to the references, and with regard to
7 advantageous distinctive features a) and c) of claims 1 and
8 4, respectively, discussed supra, contrary to the Examiner's
9 statements made at page 1, paragraph 1, lines 1-2 and at page
10 3, paragraph 6, lines 1-3, respectively, of the last Office
11 Action, Brendel et al. does not teach "...said main server...
12 requesting over the Internet that said at least one
13 participant server send the requested information over the
14 Internet back to the client..." [claim 1][Emphasis added] or
15 "requesting over the Internet, by said main server acting like
16 an orchestra leader, that said at least one nearest
17 participant server send the requested information over the
18 Internet back to the client..."[claim 4][Emphasis added], but
19 rather teaches that the load balancer 70 (relied upon by the
20 Examiner at page 3, paragraph 6, lines 3-4 of the last Office
21 Action as the main server of the present invention)
22 communicates with a server 52 over the discrete and/or
23 distinct and/or dedicated connection 120 that is independent
24 of Internet 66, as shown in figure 8 of Brendel et al.

25 With this arrangement of Brendel et al., the server 52
26 cannot be located anywhere in the world regardless of where
27 in the world the load balancer 70 is located ipso facto the
28 load balancer 70 communicates with the server 52 over the
29 discrete and/or distinct and/or dedicated connection 120.

30 Additionally, Brendel et al. disclose at col. 20, lines
31 34-37:

1 "The web farm has
2 been described as
3 having a "local"
4 network, but this
5 local network could
6 be local only in the
7 sense that it is not
8 the Internet
9 backbone."

10 Brendel et al. teach communicating between the scheduler
11 and the server with a proprietary (OSI 3rd level) protocol
12 called IXP.

13 In contradistinction, the present invention teaches
14 communicating with the participants (the equivalent of web
15 servers in Brendel et al.) from the main server (the
16 scheduler) with the standard IP (Internet Protocol) protocol
17 so that the present invention can reside where there is no
18 specialized frame relay or ISDN or leased line communication
19 between the scheduler and the participant and when there is
20 only a standard Internet connection that is using the Internet
21 backbone, which Brendel et al. simply cannot do.

22 As can be seen, Brendel et al. teaches away from the
23 present invention, a fact that must be considered in
24 determining obviousness, as was decided in General Tire and
25 Rubber Co. v. Firestone Tire and Rubber Co., 174 USPQ at 445,
26 where the Court held:

27 "In assessing the
28 prior art, the Court
29 must have regard for
30 all of the signposts
31 contained in it. It
32 must consider the
33 passages and
34 references which
35 point away from the
36 invention as well as
37 those said to point

1 toward it..."
2 [Emphasis added]"

3 To properly apply the decisional law of General Tire and
4 Rubber Co. v. Firestone Tire and Rubber Co., one must first
5 define what is considered "teaching away." The definition of
6 "teaching away" was succinctly expressed in United States v.
7 Adams, 383 U.S. 39, 52, 148 USPQ 479,484, 15 L.Ed.2D 572, 86
8 S.Ct. 708 (1966); and W.L. Gore & Assoc., v. Garlock, Inc.,
9 721 F.2d 1540, 1550-51, 220 USPQ 303, 311 (Fed. Cir. 1983),
10 cert. denied, 469 U.S. 851 (1984), where the Court held:

11 "a reference teaches
12 away if it suggests
13 that the line of
14 development flowing
15 from the reference's
16 disclosure is
17 unlikely to be
18 productive of the
19 result sought by the
20 applicant." [Emphasis
21 added]

22 The connection between the load balancer and the server
23 of Brendel et al. being through a discrete and/or distinct
24 and/or dedicated connection that is independent of the
25 Internet results in the servers not being able to be located
26 anywhere in the world regardless of where in the world the
27 load balancer is located and is therefore non-productive in
28 producing the connection between the main server and the at
29 least one participant server of the present invention being
30 through the Internet which results in the at least one
31 participant server being able to be located anywhere in the
32 world regardless of where in the world the main server is
33 located. Therefore, pursuant to W.L. Gore & Assoc., v.
34 Garlock, Inc. discussed supra, Brendel et al. teach away from
35 the present invention.

1 Brendel et al. would therefore lead a reader in a path
2 divergent from the path that was taken by appellant and
3 therefore "teaches away" from the present invention and can
4 not be used to create a prima facie case of obviousness, as
5 was decided in In re Gurley, 27 F.3d 551, 31, 31 USPQ.2d at
6 1130 (Fed. Cir. 1994), where the Court held:

7 "a reference may be
8 said to teach away
9 when a person of
10 ordinary skill, upon
11 reading the
12 reference would be
13 led in a direction
14 divergent from the
15 path that was taken
16 by the applicant
17 ...a reference that
18 "teaches away" can
19 not create a prima
20 facie case of
21 obviousness. "
22 [Emphasis added]

23 The signposts of Brendel et al. that teach away from the
24 present invention must be considered in creating a holding of
25 obviousness, as required by General Tire and Rubber Co. v.
26 Firestone Tire and Rubber Co., United States v. Adams, W.L.
27 Gore & Assoc., v. Garlock, Inc., and In re Gurley discussed
28 supra which when analyzed will clearly indicate that the
29 Examiner's combination is improper.

30 With regard to advantageous distinctive features b) and
31 d) of claims 1 and 4, respectively, discussed supra, applicant
32 respectfully draws the Examiner's attention to the fact that
33 the Federal Circuit holds that relevant case law must be
34 relied upon in determining obviousness ipso facto the
35 determination of obviousness is a matter of law, as was

1 decided in In re Deuel, 51 F.3d 1552, 1557, 34 USPQ.2d (BNA)
2 1210, 1214 (Fed. Cir. 1995), where the Court held:

3 "Obviousness is a
4 question of law,
5 which we review de
6 novo, though factual
7 findings underlying
8 the Board's
9 obviousness
10 determination are
11 reviewed for clear
12 error. In re
13 Vaeck, 947 F.2d 488,
14 493, 20 USPQ2d 1438,
15 1442 (Fed. Cir.
16 1991); In re
17 Woodruff, 919 F.2d
18 1575, 1577, 16
19 USPQ2d 1934, 1935
20 (Fed. Cir. 1990)."
21 [at 1214] [Emphasis
22 added]

23 And, in Richardson-Vicks Inc. v. The Upjohn Co., 122 F.3d
24 1476, 44 USPQ.2d 1181 (Fed. Cir. 1997), where the Court held:

25 "The difficulty with
26 RVI's position is
27 that, although the
28 argument has merit
29 when the issue is
30 purely one of fact,
31 it does not follow
32 when the issue
33 involves a question
34 of law. It is black
35 letter law that the
36 ultimate question of
37 obviousness is a
38 question of law.
39 "See Graham v. Deere
40 Co., 383 U.S. 1, 17,
41 148 USPQ 459, 467
42 (1966) (citing Great
43 A. & P. Tea Co. v.
44 Supermarket Equip.

1 Co., 340 U.S. 147,
2 155, 87 USPQ 303,
3 309 (1950)); In re
4 Donaldson Co., 16
5 F.3d 1189, 1192, 29
6 USPQ2d 1845, 1848
7 (Fed. Cir. 1994) (en
8 banc); Texas
9 Instruments Inc. v.
10 Unit States Int'l
11 Trade Comm'n, 988
12 F.2d 1165, 1178, 26
13 USPQ2d 1018, 1028
14 (Fed. Cir. 1993).
15 And we review that
16 legal question
17 without deference to
18 the trial court.
19 See Gardner V. TEC
20 Sys. Inc., 725 F.2d
21 1338, 1344, 220 USPQ
22 777, 782 (Fed. Cir.
23 1984) (district
24 court's conclusion
25 on obviousness "is
26 one of law and
27 subject to full and
28 independent review
29 in this court"). "[at
30 1183] [Emphasis
31 added]

32 In the seminal case of Graham v. John Deere Co., 383 U.S.
33 1, 17, 148 USPQ 459, 467, 15 L.Ed. 2d 545, 86 S. Ct. 684
34 (1966), the Supreme Court articulated the requirements for a
35 prima facie holding of obviousness. The Patent Office has
36 since set forth in MPEP 706.02 a three step requirement for
37 establishing a prima facie case of obviousness.

38 The first step requires that the Examiner must set forth
39 the differences in the claim over the applied references. The
40 second step requires that the Examiner must set forth the
41 proposed modification of the reference which would be

1 necessary to arrive at the claimed subject matter. And, the
2 third step requires that the Examiner must explain why the
3 proposed modification would be obvious.

4 The Courts require that in order to satisfy the third
5 step for establishing a prima facie case of obviousness, the
6 Examiner must identify where the prior art. provides a
7 motivating suggestion to make the modifications proposed in
8 the second step for establishing a prima facie case of
9 obviousness, as was expressed in the 1992 Federal Circuit
10 Court decision in In re Jones, 958, F.2d 347, 21 USPQ.2d 1941,
11 where the Court held:

12 "Contention that one
13 skilled in the
14 herbicidal art would
15 have been motivated
16 to use, with acid
17 commonly known as
18 " d i c a m b a , "
19 substituted ammonium
20 salt such as that
21 disclosed in two
22 prior references
23 does not warrant
24 holding that claimed
25 substituted ammonium
26 salt of dicamba for
27 use as herbicide is
28 prima facie obvious,
29 since there is no
30 suggestion for
31 c o m b i n i n g
32 disclosures of those
33 references either in
34 r e f e r e n c e s
35 themselves, which
36 are directed to
37 shampoo additives
38 and production of
39 m o r p h o l i n e ,
40 respectively, or in
41 knowledge generally

1 available to those
2 skilled in the
3 art. " [a t
4 1941] [Emphasis
5 added]

6 "The Solicitor
7 points out that,
8 given the breadth of
9 forms of dicamba
10 (free acid, ester,
11 or salt) disclosed
12 by Richter as having
13 herbicidal utility,
14 one of ordinary
15 skill in the art
16 would appreciate
17 that the dicamba
18 g r o u p h a s
19 significance with
20 respect to imparting
21 herbicidal activity
22 t o d i c a m b a
23 compounds. Thus,
24 the solicitor
25 contends, one
26 skilled in the art
27 would have been
28 motivated to uses,
29 with dicamba,
30 substituted ammonium
31 salts made from a
32 known amine, such as
33 the amine disclosed
34 by Zorayan and
35 Wideman, and would
36 have expected such a
37 salt to have
38 herbicidal activity.
39 Before the PTO may
40 combine the
41 disclosures of two
42 or more prior art
43 references in order
44 to establish prima
45 facie obviousness,
46 there must be some

1 suggestion for doing
2 so, found either in
3 the references
4 themselves or in the
5 knowledge generally
6 available to one of
7 ordinary skill in
8 the art." In re
9 Fine, 837 F.2d 1071,
10 1074, 5 USPQ2d 1596,
11 1598-99 (Fed. Cir.
12 1988). We see no
13 such suggestion in
14 Zorayan, which is
15 directed to shampoo
16 additives, nor
17 Wideman, which
18 teaches that the
19 amine used to make
20 the claimed compound
21 is a byproduct of
22 the production of
23 morpholine. Nor
24 does the board
25 disclosure of
26 Richter fill the
27 gap, for the reasons
28 discussed above." [at
29 1943] [Emphasis
30 added]

31 And, in Arkie Lures, Inc. v. Gene Larew Tackle, Inc., 912
32 F.Supp. 422, 38 USPQ.2d 1300 (W.D.Ark. 1996), where the Court
33 held:

34 "The existence of
35 separate elements of
36 the invention in the
37 prior art is
38 insufficient to
39 e s t a b l i s h
40 obviousness, absent
41 some teaching or
42 suggestion in the
43 prior art to combine
44 t h e

1 elements." [Emphasis
2 added]

3 And, in Gambro Lundia AB v. Baxter Healthcare
4 Corporation, 110 F.3d 1573, 42 USPQ.2d 1378 (Fed. Cir. 1997),
5 where the court held:

6 "Without a
7 suggestion or
8 teaching to combine,
9 a case of
10 obviousness is
11 deficient." [Emphasis
12 added]

13 The Courts further require, however, that even if the
14 prior art may be modified as suggested by the Examiner, the
15 modification is not made obvious unless the prior art suggests
16 the desirability of the modification, as was expressed in the
17 1992 Federal Circuit Court decision in In re Fritch, 922, F.2d
18 1260, 23 USPQ.2d 1780, where the Court held:

19 "Mere fact that
20 prior art may be
21 modified to reflect
22 features of claimed
23 invention does not
24 make modification,
25 and hence claimed
26 invention, obvious
27 unless desirability
28 of such modification
29 is suggested by
30 prior art" [at
31 1780] [Emphasis
32 added]

33 "The mere fact that
34 the prior art may be
35 modified in the
36 manner suggested by
37 the Examiner does
38 not make the
39 modification obvious
40 unless the prior art

1 suggested the
2 desirability of the
3 modification. In re
4 Gordon, 733 F.2d at
5 902, 221 USPQ at
6 1 1 2 7 . " [a t
7 1 7 8 3] [Emphasis
8 added]

9 And further, the Fritch Court at 1783 held that the
10 patent applicant may attack the Examiner's prima facie
11 determination as improperly made out and tending to support
12 a conclusion of nonobviousness:

13 "In proceedings
14 before the Patent
15 and Trademark
16 Office, the Examiner
17 bears the burden of
18 establishing a prima
19 facie case of
20 obviousness based
21 upon the prior
22 art...[The Examiner]
23 can satisfy this
24 burden only by
25 showing some
26 objective teaching
27 in the prior art or
28 that knowledge
29 generally available
30 to one of ordinary
31 skill in the art
32 would lead to that
33 individual to
34 combine the relevant
35 teachings of the
36 references. The
37 patent applicant may
38 then attack the
39 Examiner's prima
40 facie determination
41 as improperly made
42 out, or the
43 applicant may
44 present objective

1 evidence tending to
2 support a conclusion
3 of nonobviousness."
4 [Emphasis added]

5 In this same regard, the Examiner's attention is
6 respectfully drawn to the decisions in Heidelberger
7 Druckmaschinen AG v. Hantscho Commercial Products, Inc., 21
8 F.3d 1068, 30 USPQ.2d 1377; In re Fine, 837 F.2d 1071, 5
9 USPQ.2d 1596 (Fed. Cir. 1988); In re Keller, 642 F.2d 413, 208
10 USPQ 871 (CCPA 1981); and In re Merck & Co., Inc., 800 F.2d
11 1091, 231 USPQ 375 (Fed. Cir. 1986).

12 In properly applying the Graham v. John Deere Co. test
13 in light of, inter alia, In re Jones, and In re Fritch
14 discussed supra, the Examiner must conduct a rigorous
15 examination and analysis of the prior art. It would appear
16 that the Examiner has not done so.

17 Neither Brendel et al., Leighton et al, nor for that
18 matter any of the references cited by the Examiner, make any
19 motivating suggestion that, inter alia the system of Brendel
20 et al. can be modified to incorporate the teachings of
21 Leighton et al, as suggested by the Examiner.

22 The Examiner has merely combined elements in a piecemeal
23 manner in light of appellant's disclosure to show obviousness
24 by using appellant's own specification as though it were prior
25 art and in doing so has violated the basic mandate inherent
26 in 35 U.S.C. 103, as was decided in In re Kamm and Young, 17
27 USPQ 298 ff, where the Court held:

28 "The rejection here
29 runs afoul of a
30 basic mandate
31 inherent in section
32 103 - that a
33 piecemeal
34 reconstruction of
35 the prior art

1 patents in the light
2 of appellants'
3 disclosure shall not
4 be the basis for a
5 holding of
6 obviousness. "
7 [Emphasis added]

8 And, in In re Stephens, Wenzl, and Browne, 145 USPQ 656
9 (CCPA 1965), where the Court reversed a rejection on a
10 combination of references and held:

11 "References may not
12 be combined
13 indiscriminately and
14 with guidance from
15 applicant's
16 disclosure to show
17 that the claims are
18 unpatentable." [at
19 656] [Emphasis added]

20 " I n o u r
21 consideration of the
22 record in light of
23 appellants'
24 arguments, we find
25 nothing which
26 demonstrates that
27 the examiner and the
28 board erred in
29 rejecting the
30 claims. While we
31 agree with
32 appellants that
33 references may not
34 be combined
35 indiscriminately and
36 with guidance from
37 appellants'
38 disclosure to show
39 that claims are
40 unpatentable, we
41 think the
42 combination of
43 references her is
44 proper and

1 adequately suggests
2 the structure
3 appellants have
4 achieved."[at 657]
5 [Emphasis added]

6 And, in Panduit Corp. v. Burndy Corporation et al., 180
7 USPQ 498 (District Court, N.D. Illinois, E. Div.), where the
8 Court held:

9 "Inquiry into the
10 patentability must
11 be directed toward
12 subject matter as a
13 whole and not to
14 elements of a
15 combination and
16 their individual
17 novelty; combination
18 which results in a
19 more facile,
20 economical, or
21 efficient unit, or
22 which provides
23 results unachieved
24 by prior art
25 structures, cannot
26 be anticipated
27 piecemeal by showing
28 that elements are
29 individually old."
30 [at 498] [Emphasis
31 added]

32 "The inquiry into
33 the patentability
34 must be directed
35 toward the subject
36 matter as a whole
37 and not to the
38 elements of the
39 claimed combination
40 and their individual
41 novelty, and
42 therefore a patented
43 combination which
44 results in a more

1 facile, economical
2 or efficient unit,
3 or which provides
4 results unachieved
5 by prior art
6 structures, cannot
7 be anticipated
8 piecemeal by showing
9 that the various
10 elements of the
11 invention are
12 individually old.
13 The difference
14 between the subject
15 matter set forth in
16 the Re. 26,492
17 patent and the
18 subject matter of
19 the cited prior art
20 references as a
21 whole would not have
22 been obvious at the
23 time the invention
24 was made to a person
25 of ordinary skill in
26 the art to which
27 such subject matter
28 pertains, under 35
29 U.S.C. 103.[at 505]
30 [Emphasis added]

31 And, in Monarch Knitting Mach. Corp. v. Sulzer Morat
32 GmbH, 139 F.3d 877, 45 USPQ.2d 1977 (Fed. Cir. 1998), where
33 the Court held:

34 "Federal district
35 court's formulation
36 of problem
37 confronting
38 inventors of needles
39 for automatic
40 knitting machine
41 presumes their
42 solution to problem,
43 namely modification
44 of "stem segment" of
45 needles; defining

1 problem in terms of
2 its solution reveals
3 improper hindsight
4 in selection of
5 prior art relevant
6 to obviousness,
7 resulted in district
8 court adopting
9 overly narrow view
10 of scope of prior
11 art, and infected
12 district court's
13 determinations about
14 content of prior
15 art. " [a t
16 1978] [Emphasis
17 added]

18 "To ascertain the
19 scope of the prior
20 art, a court
21 examines "the field
22 of the inventor's
23 e n d e a v o r , "
24 Shatterproof Glass
25 Corp. v. Libbey-
26 Owens Ford Co., 758
27 F.2d 613, 620, 225
28 USPQ 634, 628 (Fed.
29 Cir. 1985), and
30 "the particular
31 problem with which
32 the inventor was
33 i n v o l v e d , "
34 Stratoflex, Inc. v.
35 Aerquip Corp., 713
36 F.2d 1530, 1535, 218
37 USPQ 871, 876 (Fed.
38 Cir. 1983) (quoting
39 In re Wood 599 F.2d
40 1032, 1036, 202 USPQ
41 171, 174 (CCPA
42 1979)), at the "time
43 the invention was
44 made," see 35 U.S.C.
45 § 103(a). The
46 district court

1 defined the problem
2 as "designing the
3 stem segment of a
4 k n i t t i n g
5 needle...[to]
6 minimize[] needle
7 head breakage and
8 thus maximize[] the
9 operating speed of
10 an industrial
11 knitting machine."
12 (emphasis added).
13 The '053 patent, on
14 the other hand,
15 describes the
16 inventor's problem
17 as "providing
18 [knitting needles]
19 with a means which
20 avoids head
21 breakages or lets
22 [breakages] start to
23 an extent worth
24 mentioning only at
25 higher knitting
26 speeds." '053
27 patent, col. 1,
28 lines 48-51. The
29 district court's
30 formulation of the
31 problem confronting
32 the '053 inventors
33 presumes the
34 solution to the
35 p r o b l e m -
36 modification of the
37 stem segment.
38 defining the problem
39 in terms of its
40 solution reveals
41 improper hindsight
42 in the selection of
43 the prior art
44 relevant to
45 obviousness. See,
46 e.g. In re Antle,
47 444 F.2d 1168, 1171-

1 72, 170 USPQ 285,
2 287-88 (CCPA 1971)
3 (warning against
4 selection of prior
5 art with hindsight).
6 By importing the
7 ultimate solution
8 into the problem
9 facing the
10 inventors, the
11 district court
12 adopted an overly
13 narrow view of the
14 scope of the prior
15 art. It also
16 infected the
17 district court's
18 determinations about
19 the content of the
20 prior art." [at
21 1981] [Emphasis
22 added]

23 And, in In re Rouffet, 149 F.3d 1350, 47 USPQ.2d 1453
24 (Fed. Cir. 1998), where the Court reversed the Board's
25 decision in which the level of skill in the art being high was
26 not sufficient to supply motivation:

27 "Three possible
28 sources for
29 motivation to
30 combine prior art
31 references in manner
32 that would render
33 claimed invention
34 obvious are nature
35 of problem to be
36 solved, teachings of
37 prior art, and
38 knowledge of persons
39 of ordinary skill in
40 art; high level of
41 skill in field of
42 art cannot be relied
43 upon to provide
44 necessary motivation

1 absent explanation
2 of what specific
3 understanding or
4 technical principle,
5 within knowledge one
6 of ordinary skill in
7 art, would have
8 suggested
9 combination, since
10 if such rote
11 invocation could
12 suffice to supply
13 motivation to
14 combine, more
15 sophisticated
16 scientific fields
17 would rarely, if
18 ever, experience
19 patentable technical
20 advance. " [a t
21 1 4 5 3] [Emphasis
22 added]

23 "Claimed low orbit
24 s a t e l l i t e
25 communication system
26 for mobile terminals
27 is not prima facie
28 obvious over
29 combination of two
30 p r i o r a r t
31 references, even
32 though person
33 possessing high
34 level of skill
35 characteristic of
36 this field would
37 know to account for
38 differences between
39 claimed invention
40 and prior art
41 combination, since
42 high level of skill
43 in art, without
44 more, cannot supply
45 required motivation
46 to combine

1 references, and does
2 not overcome absence
3 of any actual
4 suggestion to
5 combine; obviousness
6 rejection will not
7 be upheld, even
8 where skill in art
9 is high, absent
10 s p e c i f i c
11 identification of
12 principle, known to
13 one of ordinary
14 skill, that suggests
15 c l a i m e d
16 combination." [at
17 1454] [Emphasis
18 added]

19 The Examiner's use of improper hindsight by using
20 applicant's own disclosure as though it was prior art is
21 established beyond a reasonable doubt by the Examiner's own
22 admission in the Examiner's rational for why the proposed
23 modification would be obvious, which is stated at page 6,
24 paragraph 2, lines 3-12 of the last Office Action cited infra:

25 "...for the purpose
26 of allowing the
27 hosting scheme to be
28 far more efficient
29 than schemes that
30 cache everything
31 elsewhere, or that
32 cache objects only
33 in pre-specified
34 locations (Leighton,
35 col. 3, lines 42-57)
36 and unlimited cost
37 e f f e c t i v e
38 s c a l a b i l i t y
39 (Leighton, col. 14,
40 line 62 - col. 15,
41 line 13). Leighton
42 also suggests that
43 c o n t e n t i s

1 automatically
2 replicated to the
3 global server
4 network in an
5 intelligent and
6 efficient fashion.
7 Content is
8 replicated in only
9 those locations
10 where it is needed
11 (Leighton, col. 4,
12 lines 25-49).
13 Leighton also
14 suggests that
15 improving the Web
16 site performance and
17 avoiding the
18 expensive backbone
19 links to carry
20 redundant traffic
21 from the Content
22 Provider's Web site
23 to the network
24 exchange and access
25 points (Leighton,
26 col. 13, line 762 -
27 col. 14, line
28 49). " [Emphasis
29 added]

30 Throughout applicant's disclosure applicant makes
31 constant reference to the novelty of the present invention
32 being "to save costs by virtue of the at least one participant
33 server being relatively easy and inexpensive to add as
34 compared to clustering more servers to the main server," for
35 example in the claim:

36 "downloading the
37 requested
38 information from
39 said main server to
40 said at least one
41 nearest participant
42 server, which will
43 distribute the load

1 of said main server
2 to said at least one
3 participant server
4 when lacking
5 multicasting so as
6 to save costs, by
7 virtue of said at
8 least one
9 participant server
10 being relatively
11 easy and inexpensive
12 to add as compared
13 to clustering more
14 servers to said main
15 server" [Emphasis
16 added

17 So applicant has shown supra that the Examiner has used
18 applicant's own disclosure as though it was prior art, and by
19 doing so, has used improper hindsight in the rational for why
20 the proposed modification would be obvious, and as a result
21 thereof, pursuant to In re Kamm and Young, In re Stephens,
22 Wenzl, and Browne, Panduit Corp. v. Burndy Corporation et al.,
23 Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH, and In re
24 Rouffet discussed supra, the proposed modification cannot be
25 used for a holding of obviousness.

26 Applicant has provided clear and convincing evidence that
27 neither Brendel et al., Leighton et al., nor for that matter
28 any of the references cited by the Examiner, accomplish
29 appellant's result of providing an efficient Internet system
30 that, inter alia:

- 31 1. Enables the at least one participant server to be located
32 anywhere in the world regardless of where in the world
33 the main server is located.
- 34 2. Eliminates a need for costly multicasting if the at least
35 one participant server does not contain the requested
36 information.

1 Therefore a holding of obviousness cannot be made out,
2 as was decided by the Board of Appeals in Ex parte Tanaka,
3 Marushima and Takahashi, 174 USPQ 38, where the Board held:

4 "Claims are not
5 rejected on the
6 ground that it would
7 be obvious to one of
8 ordinary skill in
9 the art if the prior
10 art devices do not
11 accomplish
12 applicant's
13 result." [Emphasis
14 added]

15 And, in In re Wright, 122 USPQ 522 (1959), where the
16 Court held:

17 "...the mere
18 aggregation of old
19 elements that did
20 not perform a
21 different function
22 is not a patentable
23 invention, but that
24 a novel combination
25 of old elements
26 which cooperate with
27 each other to
28 produce a new or
29 useful result or a
30 substantial increase
31 in efficiency is
32 patentable." [Emphas
33 is added]

34 And, further in the en banc decision in In re Dillon, 919
35 F.2d 688, 692 (Fed. Cir. 1990), where the Court held:

36 "...a prima facie
37 case of obviousness
38 requires that the
39 prior art suggest
40 the claimed
41 compositions'
42 properties and the

1 problem the
2 applicant attempts
3 to solve." [Emphasis
4 added]

5 In this same regard, the Examiner's attention is
6 respectfully directed to the decisions in In re Halleck, 164
7 USPQ 647 (CCPA 1970); and Kockum Industries, Inc. v. Salem
8 Equipment, Inc., 175 USPQ 81 (9th Cir. 1972).

9 In light of, inter alia In re Miller, In re Fuetterer,
10 In re Ludke and Sloan, In re Chu, Schnell et al. v. The
11 Allbright-Nell Company et al., Ex parte Grasenick and Gessner,
12 Mercantile National Bank of Chicago et al v. Quest, Inc. et
13 al. DC., N.D. Indiana, In re Shelby, In re Irani and
14 Moedritzer, General Tire and Rubber Co. v. Firestone Tire and
15 Rubber Co., United States v. Adams, W.L. Gore & Assoc., v.
16 Garlock, Inc., In re Gurley, In re Deuel, Richardson-Vicks
17 Inc. v. The Upjohn Co., the Graham v. John Deere Co. test in
18 light of, inter alia MPEP 706.02, In re Jones, Arkie Lures,
19 Inc. v. Gene Larew Tackle, Inc., Gambro Lundia AB v. Baxter
20 Healthcare Corporation, In re Fritch, Heidelberger
21 Druckmaschinen AG v. Hantscho Commercial Products, Inc., In
22 re Fine, In re Keller, and In re Merck & Co., Inc., In re Kamm
23 and Young, In re Stephens, Wenzl, and Browne, Panduit Corp.
24 v. Burndy Corporation et al., Monarch Knitting Mach. Corp. v.
25 Sulzer Morat GmbH, In re Rouffet, Ex parte Tanaka, Marushima
26 and Takahashi, In re Wright, In re Dillon, In re Halleck, and
27 Kockum Industries, Inc. v. Salem Equipment, Inc. discussed
28 supra, pursuant to In re Fritch discussed supra appellant
29 attacks the Examiner's prima facie determination as being
30 improperly made out and tending to support a conclusion of
31 nonobviousness.

1 In view of the arguments presented supra, appellant
2 respectfully submits that the Examiner's grounds for the
3 Examiner's rejection of claims 1-6 under 35 U.S.C. 103(a) over
4 Brendel et al. in view of Leighton et al. are no longer
5 tenable and appellant therefore respectfully requests that the
6 Examiner withdraw the rejection.

7 In view of the above, it is submitted that the claims are
8 in condition for allowance. Reconsideration and withdrawal
9 of the rejections are requested. Allowance of claims 1-6 at
10 an early date is earnestly solicited.

11 Respectfully submitted,

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15

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